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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,233	12/12/2003	Yoshihiro Miyagawa	67161-132	9458
7590 09/28/2005			EXAMINER	
McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096			GRAYBILL, DAVID E	
			ART UNIT	PAPER NUMBER
			2822	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/733,233

Applicant(s)

MIYAGAWA, YOSHIHIRO

Examiner

David E. Graybill

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 2 pages.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

The reply filed on 7-15-5 is not fully responsive to the prior Office action because it fails to include an identification of the species that is elected from the species of a gas which is different and one of said plurality of gases continues to flow. To further clarify, applicant has attempted to elect, "the species wherein a supply into the chamber of at least one of the plurality of kinds of gases is stopped, and a gas which is different from the reaction gas and does not cause a reaction for deposition of the second insulating film flows into the chamber so that a pressure in the chamber is maintained constant." However, the claims are not restricted to this alleged species.

Because the response appears to be bona fide, but through an apparent oversight or inadvertence the response is incomplete, and in order to continue to afford applicant the benefit of compact prosecution, the requirement to complete the response within a one month time limit is waived, the amendment is entered, and the claims are examined on the merits.

Because the species of a gas which is different is recited within the alleged species applicant attempted to elect, it appears that applicant intended to elect the species of a gas which is different. Therefore, the species of a gas which is different is examined on the merits. However, applicant's listing of the claims readable thereon is incorrect. The correct

listing of the claims readable on the species of a gas which is different is claims 1-8, 10 and 12-15.

Claims 9 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7-15-5.

Claims 1-8, 10 and 12-15 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The undescribed subject matter is the claim 1 limitation, "the steps of forming said first insulating film and forming said second insulating film are alternately repeated"; and the entirety of claims 7 and 12. To further clarify, one skilled in the art would not be able to make the invention wherein the steps of forming said first insulating film and forming said second insulating film are alternately repeated because one skilled in the art would not be able to form more than one said first insulating film and one said second insulating film.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 10 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "the steps of forming said first insulating film and forming said second insulating film are alternately repeated"; and the entirety of claims 7 and 12, are incomprehensible because it appears that the step of forming said first insulating film and said second insulating film cannot be repeated because said first insulating film and said second insulating film are already formed. To further clarify, any formation of additional insulating films would not form said first and said second insulating films. For example, said first and said second insulating films are inherently formed at a particular said first insulating film location and said second insulating film location; therefore, said first and said second insulating films cannot again be formed at said first and said second insulating film locations.

In claim 12, the language, "a third insulating film is formed on a film formed later out of said first insulating film and said second insulating film" is incomprehensible because the time to which the film is formed subsequently is not given or otherwise ascertainable.

Claims 1-8, 10 and 12-15 have not been rejected over the prior art at least because, in light of the 35 U.S.C. 112 rejections supra, there is a great deal of confusion and uncertainty as to the proper interpretation of the

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limitations of the claims; hence, it would not be proper to reject the claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims. Also see *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious). See also MPEP 2143.03 and 2173.06.

**For information on the status of this application applicant should check PAIR:**

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.**

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.  
The fax phone number for group 2800 is (571) 273-8300.



David E. Graybill  
Primary Examiner  
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D.G.  
23-Sep-05